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Supreme Court, U.S.
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No. 05-1056

IN THE

Supreme Court of the United States

MICROSOFT CORPORATION,

Petitioner,

v.

AT&T CORP.,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

SUPPLEMENTAL BRIEF FOR PETITIONER

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RULE 29.6 STATEMENT

The corporate disclosure statement included in the petition for a writ of certiorari remains accurate.

SUPPLEMENTAL BRIEF FOR PETITIONER

Respondent's supplemental brief contains no new matter, only additional argument. It is an unauthorized surreply on the merits and should be stricken. *See* S. CT. R. 24.6.

1. This Court's Rule 15.8 permits a party to file a supplemental brief to "call[] attention to new cases, new legislation, or other intervening matter not available at the time of the party's last filing." S. CT. R. 15.8. Respondent's supplemental brief cites no new decisions, legislation, legal authority, or factual developments arising after the filing of the brief in opposition. It simply purports to respond to the characterization of the record below in Microsoft's reply. But this Court has never, to the knowledge of counsel for petitioner, viewed the filing of a reply brief or the arguments therein as an "intervening matter." *Cf. Bd. of License Comm'rs v. Pastore*, 469 U.S. 238, 240 (1985) (per curiam) (explaining that a supplemental brief is appropriate where it brings to the Court's attention intervening matters that may have mooted a case). It cannot be that any perceived mischaracterization of law or fact in a reply brief constitutes such a development. Otherwise, every reply brief would spawn a surreply couched as a supplemental brief, and rejoinders to those surreplies. Respondent's supplemental brief should therefore be stricken.

2. If this Court were to accept respondent's supplemental brief as permissible under Rule 15.8, its additional arguments in support of its asserted alternative ground for the decision below are without merit and should be rejected. As discussed in Microsoft's reply brief (at 6), any questions concerning the correct interpretation of "component" and "supplie[d]" in Section 271(f)(2) would be "fairly included" within the questions presented. An "answer to the question [of Section 271(f)(2)'s scope] would follow inexorably from [the Court's] discussion" of Section 271(f)(1), *United States*

v. Zolin, 491 U.S. 554, 564 n.8 (1989), because the identical contested "component" and "supplie[d] . . . from the United States" language is found in *both* Section 271(f)(1) and Section 271(f)(2). Respondent apparently no longer disputes this point. This case is therefore a perfectly appropriate vehicle for authoritatively construing this language of Section 271(f) and resolving an issue of exceptional importance to the future of the U.S. software industry.

3. Moreover, respondent's assertions that Microsoft mischaracterized the record below are utterly baseless. Respondent identifies several fragments of the record that supposedly bolster its claim that the courts below concluded that Microsoft was liable under both Section 271(f)(1) and Section 271(f)(2). Of course, the record below speaks for itself, the Court is more than capable of evaluating it independently, and a chapter-and-verse refutation of respondent's belated assertions is neither necessary nor appropriate at this stage in the proceedings. It is a sufficient answer simply to note that respondent nowhere disputes that Section 271(f)(2) requires a finding that the "component" "supplie[d] . . . from the United States" is "especially made or adapted for use in the patented invention," 35 U.S.C. § 271(f)(2), and respondent has not identified a single such finding.[1]

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[1] To the extent that respondent now contends that the relevant "component" that Microsoft "supplie[d] . . . from the United States" was not the Windows object code, but instead, some particular portion of that object code, *see* Supp. Br. of Resp. 4 n.2, that new argument cannot be reconciled with the stipulated facts. *See* Pet. App. 46a ("AT&T alleges, and Microsoft disputes, that the 'golden master disks' . . . of Windows object code constitute 'components' within the meaning of 35 U.S.C. 271(f). . . . *The parties agree that, other than the 'golden master disks' . . . of Windows object code, Microsoft does not supply any 'component' from the United States for assembly abroad.*") (emphasis added). The new argument moreover fails as a legal matter. The substantial noninfringing use inquiry focuses on *all* of a device's functions, not just on the one capable of infringing a patent. *See Hodosh v. Block Drug Co.*, 833 F.2d 1575, 1578 (Fed. Cir. 1987).

The fragment that respondent culled from the district court's opinion—"[h]ere, it is undisputed that Microsoft's object code is especially made and supplied from the United States for use in its Windows operating system" (Pet. App. 27a)—offers no support for respondent's position. The undisputed (and unsurprising) fact that Microsoft's object code is especially made "for use in its Windows operating system" hardly proves—in fact, does not even remotely suggest—that Windows is especially made for use *in AT&T's patented invention*. Nothing in respondent's most recent submission alters the fact that "respondent did not allege, the district court did not find, and Microsoft did not stipulate that Windows was 'especially made' for use in respondent's patented invention." Reply Br. 5. Accordingly, there could be, and there has been, no Section 271(f)(2) liability.

CONCLUSION

This Court should strike the Supplemental Brief of Respondent and grant the petition for a writ of certiorari.

Respectfully submitted.

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